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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,347	10/30/2003	Andrew J. Poss	H0004479	7498

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EXAMINER
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SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/697,347

Applicant(s)

POSS ET AL.

Examiner

Richard L. Schilling

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-13,15-26 is/are rejected.
- 7) ☒ Claim(s) 3-6 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1,2,7,10,11,12,13,15,17,19-20 and 22-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Hatakeyama et al '037 for the same reasons as set forth in paragraph 5 of the first office action filed 3-17-05. Monomer 2 in ex. 1 of Hatakeyama et al. is within the scope of formula b of instant claim 2 when n is 0, R is H and W, Y or Z is fluoroalkyl and within the scope of claim 12 when one n is 0 with R being H and the other n is 1 with A being CH<sub>2</sub> and R being the propanol. Monomers within the scope of the formula of claim 1 are also disclosed at col. 18, lines 27-37 and 50-59, wherein OH and CF<sub>3</sub> substituted norbornyl is disclosed.

2. Claims 1, 2, 7, 10-13, 15-20 and 22-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Hatakeyama et al. '447 for the same reasons as set forth in paragraph 4 of the first office action.

3. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hatakeyama et al. '447 or Hatakeyama et al. '037 both in view of Khojasteh et al. for the same reasons as set forth in paragraph 7 of the first office action.

4. Applicant's arguments filed 6-20-05 have been fully considered but they are not persuasive. Applicants' argument that Z excludes alkyl and OH when W, X and Y are H is unconvincing since the instant claims allow Z to be H with at least one of W, X or Y being the alkyl containing F or F.

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5. Claims 1, 2, 7, 8, 10-13 and 15-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Araki et al. '724. Araki et al. ( see particularly col. 6, lines 5-41; col. 13, line 50-col. 16, line 25; col. 33, line 10-col. 34, line 40; col. 60, lines 24-35; col. 95, lines 30-40; col. 118, lines 41-55; ex. 36, 41-44; col. 167, line 29-col. 170, line 8 ) discloses F and/or fluoroalkyl substituted norbornyl monomers within the scope of the formulas of instant claims 2 and 12. In Araki et al. Y is changed to OH by the action of acid meeting the requirements of instant claim 8.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araki et al. '724. It would be obvious to one skilled in the art to select A and B in formula V-1 of Araki et al, discussed in paragraph 5 above, to be the disclosed trifluoromethyl groups instead of H or F in monomers covered by formula V-1 including the monomers on col. 16, lines 7-20.

7. Claims 3-6 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Harada et al., Goodall et al. ( col. 18 ) and Hatakeyama et al. '501 are cited of interest as disclosing norbornyl monomers substituted with fluoroalkyl groups or F and also OH as in Hatakeyama et al.( col. 8 ).

.Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 4100 1752

